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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,625	08/31/2001	Joseph Arruda	17853-039	2365
30623	7590	10/14/2005	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			LUU, MATTHEW	
			ART UNIT	PAPER NUMBER
			3663	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/944,625	ARRUDA ET AL
	<b>Examiner</b>	<b>Art Unit</b>
	LUU MATTHEW	3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 26 September 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 26,28-32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 26, 28-32 and 36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 28 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moller et al (5,889,512).

#### **Claim 36.**

Moller discloses (Fig. 9) a cap (a rear portion 18, which includes an extension member 48 with a cap 60) (hereinafter, the rear portion 18), the cap comprising:

a first end (a screw thread aperture 42) for positioning over an end (thread bore 38) of an instrument (the grip portion 16 with the pen tip 20); and

a second end having an aperture (central aperture 44), the aperture (44) having a non-writing retractable tip (an extension member 48 with a cap 60) mounted therein. The retractable tip (an extension member 48 with a cap 60) movable between a first normal position retracted within the second aperture (Fig. 13) and a second extended position extending out of the second aperture (Fig. 15). See column 6, lines 35-47; and column 7, lines 37-38 and 62-65.

Moller fails to explicitly teach that the retractable tip (48 and 60) being adapted for use with a touch sensitive display.

However, it is obvious to a person of ordinary skill in the art to recognize that a user can use any pointing devices, such as a normal pen, a pencil, or even a finger to input information into a graphics user interface display device by touching a touch sensitive screen. Therefore, the retractable tip of Moller can function equivalently to a touch stylus for interfacing with the touch screen.

Furthermore, the claim limitations that employ phrases of the type "ADAPTED TO", "CAPABLE OF", SUFFICIENT TO', AND 'FOR' doing something are typical of claim limitations, which may not distinguish over the prior art. It has been held that the recitation that an element is "adapted to" perform or is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

### **Claim 26.**

Moller discloses (Fig. 9) a writing instrument for alternatively writing on a surface and for interfacing with a touch sensitive display, the writing instrument comprising:

an elongated body (grip portion 16 ) having a first end having a writing tip (20) and a second end (thread bore 38); and

a cap (a rear portion 18, which includes an extension member 48 with a cap 60) (hereinafter, the rear portion 18) having a first end (a screw thread aperture 42) adapted to receiving the second end (thread bore 38) of the elongated body (the grip portion 16); the cap (18) also having a second end having a second aperture (central aperture 44) with a non-writing retractable tip (an extension member 48 with a cap 60) mounted therein, wherein the second end (38) of the elongated body (grip 16, tip 20 and spring

52) cooperates with the cap (18) to extend the non-writing tip (an extension member 48 with a cap 60) outwardly from the second aperture (44) as the cap receives the second end (38) of the elongated body (grip 16, tip 20 and spring 52). See Figs 14 and 15; and column 6, lines 35-47; and column 7, lines 55-65.

Moller fails to explicitly teach that the cap adapted to receive the first end of the elongated body. Moller also fails to explicitly teach that the retractable tip (48 and 60) being adapted for use with a touch sensitive display.

Regarding to the claim limitations "the cap adapted to receive the first end of the elongated body", the Applicant should note that the phrases of the type "ADAPTED TO", "CAPABLE OF", SUFFICIENT TO', AND 'FOR' doing something are typical of claim limitations, which may not distinguish over the prior art. It has been held that the recitation that an element is "adapted to" perform or is 'capable of" performing a function is not a positive limitation but only requires the ability to so perform.

Regarding to the claim limitations "the retractable tip being adapted for use with a touch sensitive display", it is obvious to a person of ordinary skill in the art to recognize that a user can use any pointing devices, such as a normal pen, a pencil, or even a finger to input information into a graphics user interface display device by touching a touch sensitive screen. Therefore, the retractable tip of Moller can function equivalently to a touch stylus for interfacing with the touch screen.

**Claim 28.**

The rubber made material of the non-writing tip is an obvious design choice. Furthermore, it is desirable to make the stylus tip from rubber material to reduce fiction to the touch screen, provide more light weight, and reduce manufacture cost.

***Claim Rejections - 35 USC § 103***

Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moller et al as applied to claim 26 above, and further in view of the Admitted Prior Art (A.T. Cross) (Specification, page 2, lines 22-32).

**Claim 29.**

Regarding claim 29, Moller fails to teach a source for generating a signal for remotely communication with a personal digital device.

However, A.T. Cross teaches the Crosspad, which converts handwritten documents into electronic form. This Crosspad includes a conventional notepad combined with a unique pen and printed circuit board assembly (PCBA) for the notepad. A.T. Cross also teaches "the pen includes a RF transmitter. The RF transmitter operates in conjunction with the PCBA for the pad to translate pen movement into electronic signals representing the user's writing motion" (Specification, page 2, lines 26-28).

It would have been obvious to the person of ordinary skill in the art to use the RF transmitter source in the pen of the Crosspad into the stylus pen of Moller to provide a more convenient stylus input device. Furthermore, the stylus pen includes the RF

transmitter source for generating signal is well known in the art. The notepad is a personal digital device.

**Claim 30.**

A.T. Cross further teaches "A switch in the pen turns the transmitter on when the pen is in contact with the pad. The switch is activated as a result of the force exerted by the pad on the tip of the pen" (Page 2, lines 28-30).

**Claim 31.**

A.T. Cross teaches "The pen has an ink tip which can be used to make marks on the pad" (Page 2, lines 25-26). Furthermore, the ink supply positioned in the body of the pen is well known in the art.

**Claim 32.**

Since A.T. Cross teaches "A switch in the pen turns the transmitter on when the pen is in contact with the pad", it would have been obvious to the person of ordinary skill in the art to recognize that the transmitter of A.T. Cross is an electromechanical transmitter.

***Response to Arguments***

Applicant's arguments filed September 26, 2005 have been fully considered but they are not persuasive.

Claims 26 and 28-32.

The Applicant argues, at page 5, by asserting that

"moreover, in the design of Moller et al., there is no disclosure of a cap adapted to receive the first end of the elongated body. Nor is there any suggestion or motivation in Moller et al. for ... the second end of the elongated body cooperates with the cap to extend the non-writing tip outwardly from the second aperture in the cap."

Regarding to the claim limitations "the cap adapted to receive the first end of the elongated body", the Applicant should note that the phrases of the type "ADAPTED TO", "CAPABLE OF", SUFFICIENT TO', AND 'FOR' doing something are typical of claim limitations, which may not distinguish over the prior art. It has been held that the recitation that an element is "adapted to" perform or is 'capable of" performing a function is not a positive limitation but only requires the ability to so perform.

Moller et al clearly disclose the second end (38) of the elongated body (grip 16, tip 20 and spring 52) cooperates with the cap (18) to extend the non-writing tip (an extension member 48 with a cap 60) outwardly from the second aperture (44) as the cap receives the second end (38) of the elongated body (grip 16, tip 20 and spring 52). See Figs 14 and 15; and column 6, lines 35-47; and column 7, lines 55-65.

"Fig. 14 is a side cross-sectional view of stylus 10 wherein extension 14 has been pressed towards tip 20 to either engage the stop mechanism and position extension 14 in the closed position, or to disengage the stop mechanism to allow extension 14 to move to the open position (away from tip 20). When extension 14 is moved to the position shown, rotatable member 56 rotates as shown by arrow 82. This

action is described in more detail with references to Fig. 18". See column 7, lines 55-63.

**Claim 36.**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Where the tip serves a stylus, which typically is fairly sharp and which may be damaged if left exposed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Luu



MATTHEW LUU  
PRIMARY EXAMINER